



AF
22m

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICANT: Steven M. Golden, et al.)
SERIAL NO.: 09/490,362) Group No. 3622
FILED: January 24, 2000) Examiner: Raquel Alvarez
FOR: INTERACTIVE MARKETING)
NETWORK AND PROCESS USING)
ELECTRONIC CERTIFICATES)

**TRANSMITTAL OF REPLY BRIEF
TO THE BOARD OF PATENT APPEALS AND INTERFERENCES**

Commissioner of Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

Transmitted herewith is a Reply Brief (including Exhibits A-D) in response to the Examiner's Answer dated November 26, 1004.

A Request for Oral Hearing, accompanied by the fee set forth §1.17(d), was submitted with the Notice of Appeal filed on June 29, 2004.

- ☒ The commissioner is hereby authorized to charge any filing fees associated with this communication or credit any overpayment to our Deposit Account No. 14-1131.

This Reply Brief is respectfully submitted by the undersigned:

Thomas G. Scavone
Registration No. 26,801
NIRO, SCAVONE, HALLER & NIRO
181 West Madison Street - Suite 4600
Chicago, Illinois 60602
(312) 236-0733

Dated: January 25, 2005

I certify that this document and enclosed fee is being deposited on January 25, 2005 with the U.S. Postal Service as first class mail under 37 C.F.R. 1.8 and is addressed to the Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

Signature of Person Mailing Correspondence
Hannah Martin



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

APPLICANT: Steven M. Golden, et al.)
SERIAL NO.: 09/490,362) Group No. 3622
FILED: January 24, 2000) Examiner: Raquel Alvarez
FOR: INTERACTIVE MARKETING) Attorney Docket
NETWORK AND PROCESS USING) No. 2166CON2C
ELECTRONIC CERTIFICATES)

REPLY BRIEF

Honorable Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

I. INTRODUCTION

This Reply Brief of the Appellant is in response to the Examiner's Answer which was filed on November 26, 2004. (Exhibit A, Examiner's Answer). The Reply Brief is therefore timely filed on or before January 26, 2005. An oral hearing of this appeal was respectfully requested with the notice of appeal filed on June 29, 2004.

II. APPELLANT'S RESPONSE TO THE EXAMINER'S ANSWER

Before addressing the substantive content of the Examiner's Answer, the Appellant wishes to address what the Examiner has perceived to be a procedural error in the Appellant's Brief on Appeal. The Examiner stated as follows:

The brief does not contain a statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on

the decision in the pending appeal [sic] is contained in the brief. Therefore, it is presumed that there are none. The Board, however, may exercise its discretion to require an explicit statement as to the existence of any related appeals and interferences.

(Exhibit A, Examiner's Answer at p.2). The Appellant's Brief on Appeal did in fact assert that no related appeals and/or interferences exist with respect to the application at issue. Rather than providing a detailed statement to such effect in the Brief on Appeal, the Appellant provided a one word statement of "None" where required to address the related appeals and interferences. To the extent that the form or content of this statement is deficient in any way, the Appellant wishes to clarify and affirmatively assert that there are no related appeals and/or interferences that exist with respect to the application at issue.

The substantive content of the Examiner's Answer, which purports to be a response to the arguments raised in the Appellant's Brief on Appeal, fails at a fundamental level to satisfy its intentions. The Examiner's Answer completely ignores the rather compelling evidence provided within the Appellant's Brief on Appeal demonstrating why the Examiner's rejections relating to the present application are improper.

Contrary to the Examiner's position, it is quite clear that the terms "automatically" and "electronically" are not synonymous or interchangeable. The Examiner, however, continues to completely ignore the evidence which the Appellant has provided with respect to this issue. One need look no further than the very reference

that the Examiner relies upon in rejecting the claims of the present application, however, to find unequivocal proof that a distinction exists **within the field of art** in using the term "automatically" as opposed to "electronically." As discussed in the Appellant's Brief on Appeal, the Barnett reference which the Examiner relies upon discloses:

Certain coupon data may be **automatically** deleted from the user's computer after, e.g., one month, notwithstanding that the coupon, if printed, might have an expiration date in six months. This feature is included to prompt users who know of the **time-sensitive autodeletion** to promptly print (and use) coupons rather than risk having them deleted from their database.

(emphasis added) (Exhibit B, Barnett, col. 12, lines 2-8). Barnett further states,

If a particular function button 52, 54, 56, or 58 chosen by the user initiates a routine 32 which requires online communication, **that routine will initiate, control and terminate** an online session with the service provider 2 **automatically**.

(emphasis added) (Exhibit B, Barnett, col. 9, lines 29-33). Each of these excerpts from Barnett demonstrates that the drafter understood the use of the word "automatically" to be different from the use of the word "electronically." Barnett uses the term "automatically" when referring to processes which are wholly involuntary and performed spontaneously (i.e., self-initiated without manual action). The same cannot be said with respect to Barnett's use of the word "electronically". As one example, Barnett recites "the **electronic** distribution system of the preferred embodiment comprises a central located repository of

electronically stored coupon data." (Exhibit B, Barnett, col. 6, lines 30-32). The use of the term "electronically" therein quite obviously has no relation to any form of a self-initiated, automated, or time-sensitive process of any sort.

As such, it cannot fairly be said that Barnett teaches that the terms "automatically" and "electronically" are synonymous or interchangeable as the Examiner continues to assert. It is a fundamental notion of Patent Law that prior art references must be read and interpreted **as a whole** for what they fairly teach. In re Inland Steel Co., 265 F.3d 1354, 1361, 60 U.S.P.Q.2d 1396, 1401 (Fed. Cir. 2001) ("All of the disclosures in a reference, including non-preferred embodiments, must be evaluated for what they fairly teach one of ordinary skill in the art"). In the present case, the Examiner has repeatedly chosen to ignore this basic rule and use select portions of the Barnett reference to support what the Examiner perceives to be a basis for rejecting the claims of the present application. The Examiner maintains such a position in her Answer without so much as mentioning the distinction discussed above, which was raised in the Appellant's Brief on Appeal. As such, the Examiner's rejection is founded upon improper grounds and cannot stand. See In re Brouwer, 77 F.3d 422, 425, 37 U.S.P.Q.2d 1663, 1666 (Fed. Cir. 1996) ("When the references cited by the examiner fail to establish a *prima facie* case of obviousness, the rejection is improper and will be overturned").

Additionally, the Examiner's Answer, while failing to

substantively address the arguments raised in the Appellant's Brief on Appeal, does add the following which purportedly supports the Examiner's rejection of the claims of the present application:

In addition, according to Webster's Collegiate Dictionary, tenth edition, automatic is defined "**as done or produced as if by machine**" and therefore automatically equates to the meaning of electronically which is defined as "**implemented on or by means of a computer**".

(Exhibit A, Examiner's Answer at p.6) (emphasis in original). The Examiner's attempt to show that these terms are interchangeable is misplaced, not only in light of what is taught in the Barnett reference, but in light of the very definitions to which the Examiner cites when interpreted in the proper context.

For example, the definition for "automatic" which the Examiner cites is exemplified by the phrase "the answers were automatic". (See Exhibit C). In contrast, the definition for "electronic" which the Examiner cites is exemplified by the phrases "electronic food stamps" and "electronic banking". (See Exhibit D). These examples only further illustrate the inherent flaw in the Examiner's position. Automatic events or occurrences are by definition wholly involuntary, spontaneous, and self-acting. (See Exhibit C). As such, the term "automatically" unequivocally evokes connotations of both time and self-initiation. The mere fact that an automatic event or occurrence **may** take place in conjunction with the operation of an electronic device does not support the Examiner's conclusion that the terms "automatically" and "electronically" are synonymous or interchangeable. Indeed, it is

"electronically" are synonymous or interchangeable. Indeed, it is possible that the automatic coupon redemption which the present invention discloses occurs in conjunction with the operation of an electronic device. But such automatic redemption is inherently different from the electronic redemption disclosed in the prior art, as evidenced by the proper context of the dictionary definitions cited by the Examiner. This obvious distinction is only further supported by the previously illustrated distinction recognized within the Barnett reference. As such, the Examiner's position with respect to these terms is untenable, and any rejection of the Appellant's present application which stems from such a position must be withdrawn.

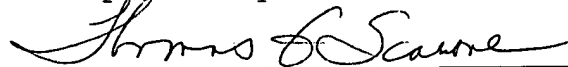
Furthermore, the Examiner's Answer fails to address the Appellant's argument that there is no suggestion or motivation to combine the references which the Examiner relies on as a basis for rejecting the claims of the application at issue. The mere fact that the references cited by the Examiner are capable of being modified by the teachings of each other does not make the modification obvious. As such, it remains improper for the Examiner to combine these references as a basis for rejecting the claims of the present application. See, In re Rouffet, 149 F.3d 1350, 1357, 47 U.S.P.Q.2d 1453, 1457 (Fed. Cir. 1998) (reversing the Board's *prima facie* obviousness rejection where, although the combination of the references taught every element of the claimed invention, the references were without a motivation to combine).

III. CONCLUSION

The Appellant respectfully submits that the references relied upon by the Examiner as a basis for rejecting the claims of the present application fail to make the claimed invention obvious in light of the proper construction of the claim term "automatically." Furthermore, there is no evidence to demonstrate a suggestion or motivation to combine the references cited by the Examiner in such a way that would result in the invention represented by the claims of the present application. As such, the Examiner has failed to meet her burden of establishing a *prima facie* case of obviousness. For the reasons stated above, the Appellant respectfully contends that the Examiner's rejection of the claims of the present application as obvious in view of the references cited by the Examiner should be withdrawn, and the Appellant's claims be found allowable.

If the Appellant successfully traverses the Examiner's obviousness rejection of the claims of the present application, the Appellant further requests that the Board direct the Examiner to withdraw the Examiner's double-patenting rejection made in light of application number 10/438,582. Such a rejection must properly be withdrawn in accordance with MPEP § 804, and will thereafter place the claims of the present application in condition for allowance.

Respectfully submitted,



Thomas G. Scavone (Reg. No. 26, 801)
NIRO, SCAVONE, HALLER & NIRO
181 West Madison Street - Suite 4600
Chicago, Illinois 60602
(312) 236-0733

Date: January 25, 2005



UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
P.O. Box 1450
ALEXANDRIA, VA 22313-1450
www.uspto.gov

**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 09/490,362
Filing Date: January 24, 2000
Appellant(s): GOLDEN ET AL.

MAILED

NOV 26 2004

GROUP 3600

Thomas G. Scavone
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 9/7/2004.

(1) *Real Party in Interest*

A statement identifying the real party in interest is contained in the brief.

(2) *Related Appeals and Interferences*

The brief does not contain a statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief. Therefore, it is presumed that there are none. The Board, however, may exercise its discretion to require an explicit statement as to the existence of any related appeals and interferences.

(3) *Status of Claims*

The statement of the status of the claims contained in the brief is correct.

(4) *Status of Amendments After Final*

No amendment after final has been filed.

(5) *Summary of Invention*

The summary of invention contained in the brief is correct.

(6) *Issues*

The appellant's statement of the issues in the brief is correct.

(7) *Grouping of Claims*

The rejection of claims 61-63 stand or fall together because appellant's brief does not include a statement that this grouping of claims does not stand or fall together and reasons in support thereof. See 37 CFR 1.192(c)(7).

(8) *Claims Appealed*

The copy of the appealed claims contained in the Appendix to the brief is correct.

(9) Prior Art of Record

6,336,099	Barnett et al.	01-2002
5,715,399	Bezos	02-1998

(10) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claims 61-63 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-16 of U.S. Patent No. 5,761,648 in view of Barnett (6,336,099 hereinafter Barnett) and Bezos (5,715,399 hereinafter Bezos). Although the conflicting claims are not identical, they are not patentably distinct from each other because the instant application further recites automatically redeeming coupons contained in said stored data base when the remote users make transaction using a credit card. Barnett teaches allowing the users to redeem the stored coupons when making purchases electronically/automatically (see figure 1 and col. 11, lines 30-40). Barnett is silent as to the form of payment used to make the purchases. Bezos teaches a method and system for communicating a credit card number over a network. The customer/user makes an on-line purchase using one or more credit cards (col. 5, lines 24-38). It would have been obvious to a person of ordinary skill in the art at the time of Applicant's invention to have included using a credit card to make the purchases because **a credit card facilitates making purchases via telephone or over the network** (in Bezos col. 1, lines 41-42).

Claims 61-63 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-16 of U.S. Patent No. 10/438,582 in view of Barnett and Bezos. Although the conflicting claims are not identical, they are not patentably distinct from each other because the instant application further recites automatically redeeming coupons contained in said stored data base when the remote users make transaction using a credit card. Barnett teaches allowing the users to redeem the stored coupons when making purchases electronically/automatically (see figure 1 and col. 11, lines 30-40). Barnett is silent as to the form of payment used to make the purchases. Bezos teaches a method and system for communicating a credit card number over a network. The customer/user makes an on-line purchase using one or more credit cards (col. 5, lines 24-38). It would have been obvious to a person of ordinary skill in the art at the time of Applicant's invention to have included using a credit card to make the purchases because **a credit card facilitates making purchases via telephone or over the network** (in Bezos col. 1, lines 41-42).

Claim Rejections - 35 USC § 103

Claims 61-63 are rejected under 35 U.S.C. 103(a) as being unpatentable over Barnett (6,336,099 hereinafter Barnett) in view of Bezos (5,715,399 hereinafter Bezos).

With respect to claim 61, Barnett teaches establishing electrical communication over the Internet between a service system plurality of remote users having personal

Art Unit: 3622

computers (i.e. the online service provider 2 transmits product information to a response unit at a customer site)(Figures 1 and 9); receiving at the service system from a plurality of issuer systems instructions for issuing the redeemable coupons (Figure 1, items 14 and 16); receiving profile data at the service system input by the remote users over the Internet (i.e. the online service provider receives user data)(see figures 1 and 9); the service system permitting remote user access to offers for redeemable coupons upon the entry of profile data requested of the remote users by the service system (see figure 1); said offers being accessible over the Internet to selective users based on analysis of the profile data (see figures 1 and 9); storing coupon files in a data base, said coupon files containing information relating to redeemable coupons offered to and selected by the remote users (see Figure 1, item 11).

With respect to automatically redeeming coupons contained in said stored data base when the remote users make transaction using a credit card. Barnett teaches allowing the users to redeem the stored coupons when making purchases electronically/automatically (see figure 1 and col. 11, lines 30-40). Barnett is silent as to the form of payment used to make the purchases. Bezos teaches a method and system for communicating a credit card number over a network. The customer/user makes an on-line purchase using one or more credit cards (col. 5, lines 24-38) . It would have been obvious to a person of ordinary skill in the art at the time of Applicant's invention to have included using a credit card to make the purchases because **a credit card facilitates making purchases via telephone or over the network** (in Bezos col. 1, lines 41-42).

With respect to claims 62-63, Barnett further teaches that the coupon file is transmitted to said database via the service system using the Internet (i.e. the Online service provider sends the coupon request file to database 11 using the Internet (See Figures 1 and 10 and col. 13, lines 58-60).

(11) Response to Argument

Appellant argues that the references fail to teach automatically redeeming coupons contained in said stored database when the remote users make transactions using a credit card. The Examiner respectfully disagree with Appellant because Barnett teaches on col. 11, lines 34-44. **"in the alternative, the coupon may be redeemed electronically by sending the coupon data in the buffer via the data communications interface 20 back to the online service provider 2. This is specially useful in the "electronic shopping mall" environment now found in many online services. The electronic coupon data could also be routed via the data communication interface 20 to a retail store where the user will be shopping, where the coupon data is held in a buffer pending purchase by the user of the matching product"**. By the above it is clear that Barnett teaches automatically, without human intervention redeeming the coupons stored in a database when making purchases. In addition, according to Webster's collegiate Dictionary, tenth edition, automatic is defined **"as done or produced as if by machine"** and therefore automatically equates to the meaning of electronically which is defined as **"implemented on or by means of a computer"**. As far as using a credit card to make the purchases. Barnett is silent as to the form of payment used to make the purchases.

Art Unit: 3622

Bezos teaches a method and system for communicating a credit card number over a network. The customer/user makes on-line purchases using one or more credit cards (col. 5, lines 24-38) . Bezos even recognizes that **a credit card facilitates making purchases via telephone or over the network** (in Bezos col. 1, lines 41-42). In addition, Barnett is an online distribution and redemption of coupons by matching the coupons to the product purchased and therefore in such an online environment using a credit card to make purchases is **old and very well known** in such an online environment where cash or other forms of payments might not be adequate.

With respect to the double patenting concerning U.S. Paten No. 5,761,648, the double patenting is sustained. Applicant has agreed to provide a terminal disclaimer therefore no further comment is necessary.

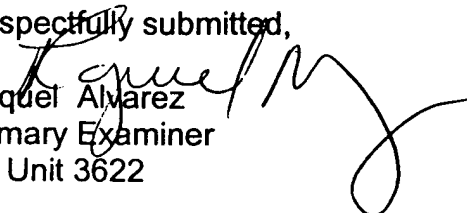
With respect to the obviousness-type double patenting rejection concerning application no, 10/438,582. Appellant cited the procedure stated in MPEP 804 that if the "provisional" double patenting rejections in both applications are the only rejections remaining in those applications, the examiner should then withdraw the rejections in one of the applications and permit the application to issue as a patent. Appellant is reminded that this is not the case in the present application because the claims were not only rejected under double patenting rejection but prior art was also applied to reject the claims. Therefore the obviousness-type double patenting rejection has been sustained.

For the above reasons, it is believed that the rejections should be sustained.

Application/Control Number: 09/490,362
Art Unit: 3622

Page 8


Respectfully submitted,


Raquel Alvarez
Primary Examiner
Art Unit 3622

R.A.

R.A.
November 23, 2004

Conferees
Eric Stamber 

James Myhre 

Michael P. Mazza
Niro, Scavone, Haller & Niro
181 W. Madison
Suite 4600
Chicago, IL 60602



Merriam-Webster OnLine

[Merriam-Webster FOR KIDS](#)
[Encyclopædia BRITANNICA](#)
[Merriam-Webster ONLINE](#)
[Merriam-Webster COLLEGIATE™](#)
[Merriam-Webster UN](#)
Merriam-Webster's College

Dictionary 11th edition. Get it
Free at Free Gift World.

Dictionary Card

New & used Dictionary Card. aff
Check out the deals now!

Target.com Official Site

Shop online & Save up to 20%.
Treat Yourself to Great Savings at
Target

Merriam Banks

Need a personal or bus
Find a Merriam bank to

Ads by

HOME	
PREMIUM SERVICES	▼
M-WCollegiate.com	
M-WUnabridged.com	
Britannica.com	
Multi-User Licenses	

DOWNLOADS	◀
WORD OF THE DAY	◀
WORD GAMES	◀
WORD FOR THE WISE	◀
ONLINE STORE	◀
HELP	◀

Merriam-Webster Inc.
Company information

Merriam-Webster Online Dictionary

One entry found for **automatic**.

[Thesaurus](#)

Main Entry: **1** *au·to·mat·ic*

Pronunciation: "o-t&- 'ma-tik

Function: *adjective*

Etymology: Greek *automatos* self-acting, from *aut-* + *-motos* (akin to Latin *ment-*, *mens* mind) -- more at **MIND**

1 a : largely or wholly involuntary; *especially* : **REFLEX** **5**
<*automatic* blinking of the eyelids> **b** : acting or done
spontaneously or unconsciously **c** : done or produced as if
by machine : **MECHANICAL** <the answers were *automatic*>

2 : having a self-acting or self-regulating mechanism

3 of a firearm : using either gas pressure or force of recoil
and mechanical spring action for repeatedly ejecting the
empty cartridge shell, introducing a new cartridge, and
firing it

synonym see **SPONTANEOUS**

- *au·to·mat·ic·al·ly* /-ti-k(&-)lE/ *adverb*

- *au·to·ma·tic·ity* /-m&- 'ti-s&-tE, -ma-/ *noun*

For **More Information on "automatic"** go to **Britannica.com**

Get the **Top 10 Search Results for "automatic"**

Merriam-Webster
☒ **Dictionary**
☐ **Thesaurus**

**Tsunami Dis
Relief**

Click here for a list
charitable organiz
from USAID.

[Donate Now](#)

Palm & Pock

Browse and downl
Merriam-Webster
e-books and game
Palm and Pocket P
and Mobile Phones
Merriam-Web
Online Store

Merriam-Wel
Collegiat
14-day Free



Merriam-Webster OnLine

[Merriam-Webster FOR KIDS](#)
[Encyclopædia BRITANNICA](#)
[Merriam-Webster ONLINE](#)
[Merriam-Webster COLLEGIATE®](#)
[Merriam-Webster UN](#)

Merriam-Webster's College
Dictionary 11th edition. Get it
Free at Free Gift World.

Electronic Dictionary
Talking dictionaries/translators for
more than 30 languages

Italian Pronunciation
Practise and improve your Italian
pronunciation.

Electronic Dictionary
Get Free \$250 Gift Card
Electronic Dictionary - a

Ads by

HOME
PREMIUM SERVICES ▼
M-WCollegiate.com
M-WUnabridged.com
Britannica.com
Multi-User Licenses

DOWNLOADS ◀
WORD OF THE DAY ◀
WORD GAMES ◀
WORD FOR THE WISE ◀
ONLINE STORE ◀
HELP ◀

Merriam-Webster Inc.
Company information

Merriam-Webster Online Dictionary

One entry found for **electronic**.

[Thesaurus](#)

Merriam-Webster
☒ **Dictionary**
☐ **Thesaurus**



Main Entry: **elect·ron·ic** ˈlek-ˈträn-ik
Pronunciation: i-"lek-'trä-nik
Function: *adjective*
1 : of or relating to electrons
2 : of, relating to, or utilizing devices constructed or
working by the methods or principles of electronics; *also* :
implemented on or by means of a computer <*electronic* food
stamps> <*electronic* banking>
3 **a** : generating musical tones by electronic means <an
electronic organ> **b** : of, relating to, or being music that
consists of sounds electronically generated or modified
4 : of, relating to, or being a medium (as television) by
which information is transmitted electronically <*electronic*
journalism>
- **elect·ron·i·cal·ly** ˈlek(-)lE/ *adverb*

For **More Information on "electronic"** go to [Britannica.com](#)
Get the **Top 10 Search Results for "electronic"**

Tsunami Dis-
Relief
Click here for a list
charitable organiz
from USAID.
[Donate Now](#)

Palm & Pock
Browse and downl
Merriam-Webster
e-books and game
Palm and Pocket P
and Mobile Phones
[Merriam-Web-](#)
[Online Store](#)

Merriam-Web-
Collegiat
14-day Free